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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,851	05/06/2005	Stephane Schaal	07040.0201	4303
22852	7590	02/13/2008	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			02/13/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,851	SCHAAL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Katarzyna Wyrozebski	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-44 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/06/05; 30/09/04</u> .                                      | 6) <input type="checkbox"/> Other: ____ .                         |

***Claim Objections***

1. Claims 9-21, 29-32, 40-44 are objected to because of the following informalities: Claims 9-21, 30-32, 41-44 are improper multiply dependent claims. Appropriate correction is required.

*Note:* Applicants claim 2 is directed to a tire wherein carcass contains bead wires, belt, tread band and sidewalls. These elements are necessary and unavoidable structural elements of every tire, and therefore are viewed as inherent, intrinsic or otherwise obvious to the tire construction and therefore are automatically taught by tire references described below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over EZAWA (US 2002/0177641) in view of NAKAMURA (US 6,333,375) or vice-versa.

The prior art of EZAWA discloses composition for a tire [0004], specifically tire tread. Please see examples in Table I for anticipatory composition.

Rubber – diene rubber or mixture of diene rubbers 100 pbw

Reinforcing filler – silica

Stearic acid - 2 pbw

Zinc oxide – 3 pbw, and

Stearic acid amide – 0.75 pbw.

In the disclosure of EZAWA, SBR1500 is a JSR tradename and it is cold emulsion polymerized SBR with glass transition temperature of less than 5°C. Rubbers are all diene rubbers and specific examples include SBR, BR (examples) as well as EPR and butyl rubbers [0020].

The composition of EZAWA also discloses use of other customary additives such as sulfur based vulcanizing agents, silane coupling agents as well as additional reinforcing fillers, such as carbon black. Specification also discloses wider ranges of the components discussed above. Specifically the range for fatty acid amide is 0.3-10 pbw [0014].

Addition of fatty acid amide as disclosed in EZAWA improves dispersion of silica within polymeric matrix.

The prior art of NAKAMURA as disclosed in TABLES III, IV and V of this prior art discloses also composition for tire tread comprising following:

Rubber – diene rubber or mixture of diene rubbers 100 pbw

Reinforcing fillers – silica

Zinc oxide - 2-3 pbw

Stearic acid – 2-3 pbw

Fatty acid salt – 3 pbw

Wherein fatty acid salt is defined in specification, col. 14, wherein zinc salts of the fatty acids are listed as preferred embodiments. Examples include zinc stearate.

The prior art of NAKAMURA also teaches use of other customary additives in the tire industry and these customary additives include also vulcanizing agents, silane coupling agents as well as additional reinforcing fillers such as carbon black.

As per teachings of NAKAMURA composition that utilizes salts of fatty acids has improved heat build-up, abrasion resistance and processability, since fatty acids are known lubricants.

The combination of two known compositions is expected to work in additive or cumulative manner. *In re Kerkhoven* 626 E.2d 846, 850 205 USPQ 1069, 1072 (CCPA 1980).

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to combine the compositions of EZAWA and NAKAMURA and thereby arrive at a tire tread with improvements suggested by both disclosure, wherein the tire tread would have better dispersion of filler, specifically silica, within diene elastomer matrix as well as lower heat build-up, processability and tensile properties.

6. Claims 1-6, 9-13, 15-26, 29-36, 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over AQUIRE (US 5,656,680).

The prior art of AQUIRE discloses composition for tire that comprises processing aid. As per example 6 (col. 16) the processing aid comprises 7 pbw of stearamide and 16 pbw of zinc stearate. Table I further teaches the rest of the components, which include stearic acid 2 pbw and zinc oxide 3 pbw.

Rubber of AQUIRE is diene rubber such as SBR and/or BR, EPD rubber (col. 10) and the like.

The only deficiency of the composition is that prior art discloses the use of 16 pbw of zinc stearate while the present claims require 15 pbw

It is apparent, however, that the instantly claimed 15 pbw and that taught by AQUIRE 16 pbw are so close to each other that the fact pattern is similar to the one in In re Woodruff , 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a “slight” difference in the ranges the

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court held that such a difference did not “render the claims patentable” or, alternatively, that “a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the 16 pbw of fatty acid salt disclosed by AQUIRE and the 15 pbw disclosed in the present claims and further given the fact that no criticality is disclosed in the present invention with respect to the upper range of salt of fatty acid, it therefore would have been obvious to one of ordinary skill in the art that the amount disclosed in AQUIRE disclosed in the present claims is but an obvious variant of the amounts disclosed in present invention and thereby one of ordinary skill in the art would have arrived at the claimed invention.

During search the examiner found references to SANDSTROM, which although very much applicable against present claims, does not qualify as a prior art: US 2007/0144645, US 2007/0187012; US 2006/0130954; US 7231951; and US 7, 207,366, especially Table III, examples J, K, M and N.

On 9/30/2004 the applicants amended specification in several places. It is USPTO practice to submit an entire paragraph with changes or additions either underlined much like with the claims. The amendment to the specification is therefore objected to.

In addition, since instant invention is a 371 continuation, the first paragraph should contain priority information. Applicants are requested to incorporate such information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katarzyna Wyrozebski/  
Primary Examiner, Art Unit 1796

February 11, 2008